

RECEIVED
CENTRAL FAX CENTER

MAY 11 2007

Customer No. 27061
Conf. No. 2764

Patent Application
Attorney Docket No. GEMS8081.115

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of : Toth et al.
Serial No. : 10/063,420
Filing Date : 4/22/2002
For : Method and Apparatus of Modulating Radiation
Filtering During Radiographic Imaging
Group Art No. : 3737
Examiner : Ramirez, John F.

CERTIFICATION UNDER 37 CFR 1.8(a) and 1.10

I hereby certify that, on the date shown below, this correspondence is being:

Mailing

deposited with the US Postal Service in an envelope addressed to Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450

37 CFR 1.8(a)

37 CFR 1.10

with sufficient postage as first class mail As "Express Mail Post Office to Addressee" Mailing Label No.

Transmission

transmitted by facsimile to Fax No.: 571-273-8300 addressed to Director Karen M. Young at the Patent and Trademark Office.

Date: May 11, 2007

/Kevin R. Rosin/
Signature

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

**PETITION UNDER 37 C.F.R. §1.181 SEEKING SUPERVISORY REVIEW
OF REQUIREMENT FOR INFORMATION AND IMPROPER USE OF
NOTICE OF NON-COMPLIANT AMENDMENT**

Dear Sir:

Responsive to the Requirement for Information mailed June 7, 2006, and subsequent Notice of Non-Compliant Amendments mailed December 11, 2006 and April 11, 2007, Applicant requests Supervisory Review and consideration of the Remarks set forth below:

Toth et al.

S/N: 10/063,420

REMARKS

In the Office Communication mailed June 7, 2006, the Examiner imposed a Requirement for Information under 37 CFR 1.105. Therein, the Examiner directed Applicant to disclose all co-pending applications and related patents that may be related to the current application and identify specific claims of those applications and/or patents that may present double patenting issues with the instant application claims. In the reply dated September 7, 2006, Applicant listed those co-pending applications and patents believed to be relevant to examination of the current application; however, Applicant stated that the additional request to identify claims that may present double patenting issues was improper and overly broad.

In response to Applicant's reply, the Examiner mailed a Notice of Non-Compliant Amendment under 37 CFR 1.121 on December 11, 2006, stating that "[t]he response filed September 7, 2006 is non-compliant because while the applicant listed 11 related applicants [sic] and patents, the applicant objected to and did not identify specific claims of those applications or patents which may present double patenting issues with the instant application claims." Responsive thereto, Applicant filed a response on January 11, 2007, stating that (1) the Examiner's use of a Notice of Non-Compliant Amendment under 37 CFR 1.121, regarding the reply filed on September 7, 2006, was improper, and that (2) the reply filed September 7, 2006, was fully responsive to the Requirement for Information under the guidelines set forth for such a requirement in MPEP §704.11 and that the Examiner's broad request made in the Requirement is not consistent with the scope of 37 CFR 1.105.

The Examiner again mailed another Notice of Non-Compliant Amendment under 37 CFR 1.121 on April 11, 2007, identical to the prior Notice of Non-Compliant Amendment mailed on December 11, 2006, dismissing Applicant's reply seemingly without even acknowledging or addressing Applicant's arguments.

For the reasons set forth herein below, Applicant respectfully requests review of the Examiner's continued use of a Notice of Non-Compliant Amendment under 37 CFR 1.121. Furthermore, Applicant believes that the reply filed September 7, 2006, was fully responsive to the Requirement for Information under the guidelines set forth for such a requirement in the MPEP.

Toth et al.

S/N: 10/063,420

Examiner's Improper Use of Notice of Non-Compliant Amendment Under 37 CFR 1.121

As stated above, Applicant respectfully believes that the Examiner's use of a Notice of Non-Compliant Amendment under 37 CFR 1.121, regarding the reply filed on September 7, 2006, is improper. While Applicant objected in part to the Requirement for Information imposed by the Examiner, no amendments were made to the current application in that response. Accordingly, the use of a Notice of Non-Compliant Amendment under 37 CFR 1.121 is improper and it is requested that such Notice be withdrawn. 37 CFR 1.121 is entitled "Manner of making amendments in applications" and sets forth rules governing the proper form and procedure for submitting amendments to an application. That is, it provides information on the proper manner to, and stylistic rules for, amending an application. A review of the Examiner's Notice of Non-Compliant Amendment reveals that the reasons for such Notice, that Applicant failed to provide a listing of claims relevant to a possible double patenting issue, clearly departs from the substance of 37 CFR 1.121.

Furthermore, MPEP §714 sets forth when it is proper for an Examiner to send a Notice of Non-Compliant Amendment under 37 CFR 1.121 to an Applicant. MPEP §714 states that "[i]f an amendment... fails to comply with 37 CFR 1.121, the Office will notify applicant by a Notice of Non-Compliant Amendment, Form PTOL-324, that the amendment fails to comply with the requirements of 37 CFR 1.121..." *MPEP §714(II)(F)* (emphasis added). Therefore, per MPEP §714(II)(F), a Notice of Non-Compliant Amendment should only be prepared when there is an amendment that fails to comply with 37 CFR 1.121. No amendments were made in the response of September 7, 2006, and as such, the Examiner has provided no grounds for the issuance of a Notice of Non-Compliant Amendment under 37 CFR 1.121.

For these reasons, Applicant respectfully believes that the Notice of Non-Compliant Amendment under 37 CFR 1.121, mailed on December 11, 2006 and on April 11, 2007, are improper and should be withdrawn.

Response to Requirement for Information Under 37 CFR 1.105

In the Requirement for Information under 37 CFR 1.105 of June 7, 2006, the Examiner directed Applicant to disclose all co-pending applications and related patents that may be related to the current application. Responsive thereto, reasonable inquiries were made to those responsible under 37 CFR 1.56(c) and to the assignee of the present application, and a list was

Toth et al.

S/N: 10/063,420

provided of those co-pending applications and patents believed to be relevant to examination of the current application.

The Examiner also directed Applicant to "identify the specific claims of those [related] applications and/or patents which may present double patenting issues with the instant application claims." *Office Action, June 7, 2006*, p. 2. As stated in the reply filed September 7, 2006, Applicant respectfully believes that imposing such a requirement on a patent applicant is not proper and is overly broad. An examination of 37 CFR 1.105 reveals the purpose of Requirements for Information and the limits to such requirements. As set forth in 37 CFR 1.105, "[r]equirements for factual information known to applicant may be presented in any appropriate manner..." (emphasis added). That is, as set forth in MPEP §704.11, "[t]he terms 'factual' and 'facts' are included in 37 CFR 1.105 to make it clear that it is facts and factual information, that are known to applicant, or readily obtained after reasonable inquiry by applicant, that are sought, and that *requirements under 37 CFR 1.105 are not requesting opinions that may be held or would be required to be formulated by applicant.*" MPEP §704.11 (emphasis added). From this, it is clear that any Requirement for Information under 37 CFR 1.105 should only seek to obtain facts from an applicant, not opinions. The requirement imposed on Applicant by the Examiner to identify specific claims of those applications or patents which may present double patenting issues with the instant application claims, is clearly requesting an opinion and is therefore contrary to the very specific rule set forth in MPEP §704.11.

Additionally, MPEP §704.11(a) lists examples of information reasonably required to be provided by an applicant. At most, it appears that subsection (G) is most closely relevant to this issue, which states that information required for examination may include "[i]dentification of pending or abandoned applications filed by at least one of the inventors or assigned to the same assignee as the current application that disclose similar subject matter that are not otherwise identified in the current application." MPEP §704.11(a)(G). Applicant has so complied. MPEP §704.11(a) does not authorize an examiner to require an applicant to formulate opinions on potential double patenting claims in those related applications and/or patents. As stated above, MPEP §704.11 actually restricts an examiner from requiring an Applicant to formulate such opinions.

In sum, the Examiner has not provided a valid basis for requiring Applicant to identify specific claims in the applications and/or patents identified by Applicant which may present

Toth et al.

S/N: 10/063,420

double patenting issues with the instant application claims. Such a requirement is improper and, in fact, is contradictory to the scope of a Requirement for information under 37 CFR 1.105 and MPEP §704.11.

For these reasons, Applicant believes that the reply previously filed on September 7, 2006, is fully responsive to the Requirement for Information under 37 CFR 1.105. Applicant also believes that the Examiner has no support in either the CFR or MPEP for the continued requirement that Applicant identify specific claims which may present double patenting issues with the instant application claims, or for issuing a Notice of Non-Compliant Amendment where no actual amendment is being made.

Applicant believes no fee is due for filing the Petition; however, should a fee be deemed necessary, Applicant hereby authorizes charging of Deposit Account No. 07-0845.

Applicant appreciates the Director's consideration of these Remarks and cordially invites the Director to call the undersigned, should the Director consider any matters unresolved.

Respectfully submitted,

/Kevin R. Rosin/

Kevin R. Rosin
Registration No. 55,584
Phone 262-268-8100 ext. 15
krr@zpspatents.com

Dated: May 11, 2007
Attorney Docket No.: GEMS8081.115

P.O. ADDRESS:

Ziolkowski Patent Solutions Group, SC
136 South Wisconsin Street
Port Washington, WI 53074
262-268-8100